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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,560	10/13/2006	John Waterfield	ENI-355-A	1844
48980	7590	01/02/2008	EXAMINER	
YOUNG & BASILE, P.C. 3001 WEST BIG BEAVER ROAD SUITE 624 TROY, MI 48084			PARKER, FREDERICK JOHN	
			ART UNIT	PAPER NUMBER
			1792	
			NOTIFICATION DATE	DELIVERY MODE
			01/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@youngbasile.com
audit@youngbasile.com

Office Action Summary	Application No.		Applicant(s)	
	10/553,560		WATERFIELD, JOHN	
	Examiner		Art Unit	
	Frederick J. Parker		1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 102

The amendments in response to the 35 USC 102 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejections under this heading of the prior Office Action are withdrawn; the new rejections are necessitated by Applicants new amendments.
3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer WO 97/09179 in view of the APA and Gust US 2002/0110647
4. Schafer teaches an improved measuring device/ ruler in which a transparent material, especially acrylic, is screen printed with thick lines to form multi-colored gradations which form the measuring units in at least one stage (pages 1,2,7,8 and elsewhere). The printing of "UV cured inks per claim 4 is taught (page 3, top). While non-slip characteristics is not cited, the APA states on page 1 that it is known and conventional in the art that rulers require non-slip characteristics which are imparted by additions of a filler such as fine sand or pumice to applied coatings. Given that knowledge, one of ordinary skill would have looked to slip resistant coatings for application to the device/ ruler of Schafer, and therefore have looked to the teachings of Gust et al which cite the use of clear UV curable coatings comprising similar filler

materials (e.g. silicon dioxide, which encompasses “sand”, ground glass, glass beads, etc per claim 3) which imparts handling, scratch resistance or other attributes [017]. Given the similarity of fillers, the coating would have been expected to impart slip resistance. When a reference discloses the limitations of a claim except for a property, and the Examiner cannot determine if the reference inherently possesses that property (in this case, slip resistance), the burden is shifted to Applicant/s, In re Fitzgerald 205 USPQ 594 and MPEP 2112. Such UV coatings, which may contain photo initiators [030 and examples, etc] (claim 2) cure immediately on contact with UV, providing the obvious benefit of rapid curing versus slower curing coatings [0027]. Polymer substrates are cited for such coatings, including previously coated polymer surfaces [0032,0034, 0037,etc]. Coloration of applied markings may be multi-color (page 10, top, of Schafer), the coloration of the lines being merely an obvious variation to supply image contrast and/ or decorative effects. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431.

The prior art teaches it is known to apply screen printed, abrasion resistant inks as patterns onto clear plastic surfaces which impart abrasion resistance. The patentability of a product is based upon the product itself as claimed, and not upon its method of production. The product of the prior art would have been a measuring device/ ruler with cured UV inks including transparent lacquers (clm 9) by screen printing, the ink comprising sand , pumice, or like fillers (clm 12) to form single or multi-color lines (clm 10-11). The limitation of claim 6 and the preamble of claim 8 are directed towards intended use, which hold no patentable weight. The product of claims 5-

12 would have been obvious in view of the prior art rejections above, and therefore would be unpatentable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the ruler/ device of Schafer using screen printing to form colored gradations and further imparting non-slip characteristics known according to the APA by further substituting or incorporating the specific UV curable coating materials containing the fillers of Gust et al to provide the ruler with a wear and slip resistant surface formed by UV curing.

Response to Arguments

5. Applicants argue Gust is not analogous art. In response to applicant's argument that Gust is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gust is directed towards applying scratch-resistant UV curable coatings comprising inorganic particle fillers (e.g. silica) which are applied onto polymer substrates. Since the recited rejection utilizes plastic substrates 76, and further requires a scratch/ abrasion resistant end product, Gust is certainly in the same field of endeavor and pertinent to the problem at hand, as described to which one of ordinary skill would have looked to for means of applying scratch-resistant coatings. Hence Applicants argument is not persuasive. Thickness is not relevant because Applicants claims do not require a specific thickness, and further there would have been the reasonable expectation that the coatings on any adherent plastic surface would have resulted in

scratch-resistant coatings. Gust is not cited for stretching coated substrates but rather the simple concept of applying coatings to suitable plastic substrates to form abrasion-resistant coatings.

Amended or new article claims 7-12 are obvious in view of the prior art, as previously discussed in the rejections and which reasoning will not be repeated for brevity.

The Examiner has provided a prima facie case of obviousness over claims 1-12, and accordingly the rejection is made FINAL.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frederick J. Parker
Primary Examiner
Art Unit 1792

fjp